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PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Kurt W. Getreuer

Filed: June 7, 1995

Serial No: 08/485,070

For: METHOD AND APPARATUS FOR
MOVING CARRIAGE ASSEMBLY
FROM INITIAL POSITION TO
TARGET POSITION AND OPTICAL
DISC SYSTEM INCLUDING SAME
(AS AMENDED)

§ Art Unit: 2752
§
§ Examiner: DINH, Tan
§
§ Attorney Docket Number:
§ 951028(US)USC1X1X1D1 MMMI
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§

COMMUNICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant hereby respectfully requests the withdrawal of the Terminal Disclaimer filed on October 25, 1999 to obviate a double patenting rejection.

Applicant also respectfully requests reconsideration of the rejection of claims 1, 17-71 under the judicially created doctrine of double patenting over claims 1-16 of U.S. Patent No. 5,677,899. This rejection was made by the Examiner in the Office Action mailed on April 26, 1999. In that Office Action, the Examiner applied the two-part test set forth in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) and MPEP § 804. Under the *In re Schneller* two-part test, double patenting is considered to exist where (1) the subject matter recited in the claims of the application are fully disclosed in the patent and covered by a claim in the patent, and (2) where there is no reason why Applicant was prevented from presenting the same claims for examination in the issued patent. In the April 26, 1999 Office Action, the Examiner applied this two-part test and concluded that double patenting was present.

Applicant respectfully brings to the attention of the Examiner the decision by the

Board of Patent Appeals and Interferences in the case *Ex parte Davis et al.* (Appeal No. 1999-1924) dated May 1, 2000 (copy enclosed), wherein the Board stated that *In re Schneller* was "not another test for determining obviousness-type double patenting" and that *In re Schneller* was of "doubtful controlling precedent". The Board also went on to state "it is our view that *Schneller* did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision". Accordingly, the Board rejected the *Schneller* two-part test and analyzed the case on whether the application claims are patentably distinct from the claims of the issued patent. The Board found that the application claims were patentably distinct and reversed the *Schneller* rejection.


Applicant also encloses three similar recent decisions of the Board of Patent Appeals for the Examiner's review: *Ex parte Bailey* (Appeal No. 1996-1838; *Ex parte Dakin* (Appeal No. 1999-0189); and *Ex parte Dakin* (Appeal No. 1999-1447).

In view of the decision in *Ex parte Davis et al.*, Applicant respectfully requests that the Examiner reconsider the rejection of claims 1, 17-71 under the judicially created doctrine of double patenting over claims 1-16 of U.S. Patent No. 5,677,899 and requests the withdrawal of the Terminal Disclaimer filed on October 25, 1999.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, he is herein requested to call Applicant's attorney at the phone number noted below.

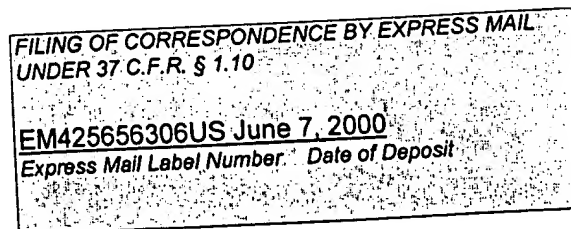
Respectfully submitted,

DISCOVISION ASSOCIATES


Donald L. Wensky
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Date: June 7, 2000

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Paper No. 35

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Steptoe & Johnson LLP

Ex parte MARVIN B. DAVIS and KENT MURPHY **BOARD OF PATENT APPEALS
AND INTERFERENCES**

Appeal No. 1999-1924
Application No. 08/486,545

CORRECTION TO THE MAY 1, 2000 DECISION ON APPEAL

The decision on appeal contained the following error. Page 1, line 1, "THIS OPINION WAS NOT WRITTEN FOR PUBLICATION" should be deleted.

A corrected copy of page 1 of the decision on appeal is attached hereto.

The decision of May 1, 2000 is modified only to the extent indicated above.

BRUCE H. STONER, JR.
Chief Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

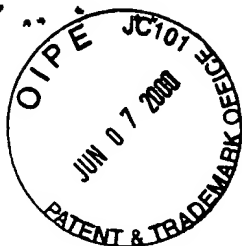
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The opinion in support of the decision being entered today
is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARVIN B. DAVIS and KENT MURPHY

Appeal No. 1999-1924
Application No. 08/486,545

HEARD: March 22, 2000

Before STONER, Chief Administrative Patent Judge, HAIRSTON and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection (Paper No. 11, mailed December 12, 1996) of claims 1
and 21 to 27, which are all of the claims pending in this
application.¹

We REVERSE.

¹ While the examiner in the Advisory Action of February 13,
1997 (Paper No. 14) has approved entry of the amendment to claims
1 and 27 (Paper No. 13, filed January 24, 1997) submitted
subsequent to the final rejection, we note that this amendment
has not been clerically entered.

BACKGROUND

The appellants' invention relates to a cartridge loading apparatus for use with a disk drive. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The rejections on appeal as set forth in the examiner's answer (Paper No. 24, mailed September 28, 1998) are²:

1. Claims 1 and 21 to 27 stand rejected under the judicially created doctrine of nonstatutory (i.e., obviousness-type) double patenting over claim 1 of U.S. Patent No. 5,684,776, claim 1 of U.S. Patent No. 5,703,857 and claim 1 of U.S. Patent No. 5,724,331 since the claims at issue are not patentably distinct inventions from the issued claims.

2. Claims 1 and 21 to 27 stand provisionally rejected under the judicially created doctrine of nonstatutory double patenting over claim 1 of copending Application No. 08/482,052.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection and the

² The rejection of claim 27 under 35 U.S.C. § 112, second paragraph, set forth in the final rejection was overcome by the appellants' amendment after final rejection as noted in the Advisory Action of February 13, 1997 (Paper No. 14).

answer for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 23, filed November 7, 1997) and reply brief (Paper No. 29, filed November 30, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions set forth by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the decision of the examiner to reject claims 1 and 21 to 27 under the judicially created doctrine of double patenting must be reversed. Our reasoning for this determination follows.

Double patenting is a legal doctrine that forbids an inventor from obtaining a second valid patent for either the same invention or an obvious modification of the same invention claimed in that inventor's first patent. See In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). The basic concept of double patenting is that the same invention cannot be patented more than once since to do so would result in a second patent that would expire some time after the first patent expired

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and extend the protection timewise. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279-80, 23 USPQ2d 1839, 1845 (Fed. Cir. 1992); In re Kaplan, 789 F.2d 1574, 1579-80, 229 USPQ 678, 683 (Fed. Cir. 1986).

35 U.S.C. § 101 states "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor..." (Emphasis added). The prohibition of double patenting of the same invention is based on 35 U.S.C. § 101. In re Goodman, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993); Longi, 759 F.2d at 892, 225 USPQ at 648. By "same invention," the court means "identical subject matter." Longi, 759 F.2d at 892, 225 USPQ at 648; In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 621 (CCPA 1970). A good test, and probably the only objective test, for "same invention," is whether one of the claims would be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. Vogel, 422 F.2d at 441, 164 USPQ at 621-22 (halogen is not the "same" as chlorine; meat is not the "same" as pork). All types of double patenting which are not "same invention" double patenting have come to be referred to as "obviousness-type" double patenting. See In re Van Ornum, 686

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F.2d 937, 942-43, 214 USPQ 761, 766 (CCPA 1982), which states in discussing cases leading to Vogel's restatement of the law of double patenting,^{3,4}

numerous cases were considered in which application claims were directed to mere obvious modifications of, or improvements on, inventions defined in the claims of patents already issued to the same inventors, or to common assignees, and it had been decided that they might be allowed to go to patent if the applicants filed terminal disclaimers. We classified these as "obviousness type double patenting." This latter classification has, in the course of time, come, somewhat loosely, to indicate any "double patenting" situation other than one of the "same invention" type.

See also General Foods, 972 F.2d at 1279-80, 23 USPQ2d at 1844-45.

"Obviousness-type" double patenting extends the fundamental legal doctrine to preclude "obvious variants" of what has already been patented. See In re Berg, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998); Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015 and General Foods, 972 F.2d at 1280, 23 USPQ2d at 1845. "Obviousness-type" double patenting precludes issuance where there is no "patentable difference" or no "patentable

³ Vogel, 422 F.2d at 441-42, 164 USPQ at 621-22.

⁴ Judge Rich in Kaplan, 789 F.2d at 1579, 229 USPQ at 682, stated that the restatement of the law of double patenting set forth in Vogel "serves as a good starting place" for deciding the double patenting issue raised in that appeal.

distinction" between the two claims. Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015; General Foods, 972 F.2d at 1278-79, 23 USPQ2d at 1844. This allows the public to practice obvious variations of the first patented invention after the first patent expires. See Longi, 759 F.2d at 892-93, 225 USPQ at 648. The courts adopted the doctrine out of necessity where claims in two applications by the same inventor were so much alike that to allow the latter would effectively extend the life of the first patent. See Gerber Garment Technology, Inc. v. Lectra Sys., 916 F.2d 683, 686 16 USPQ2d 1436, 1439 (Fed. Cir. 1990); In re Thorington, 418 F.2d 528, 534, 163 USPQ 644, 648 (CCPA 1969), cert. denied, 397 U.S. 1038, 165 USPQ 290 (1970).

In summary, "obviousness-type" double patenting is a judge-made doctrine that prevents an unjustified extension of the patent right beyond the statutory time limit. It requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide an unjustified extension of the term of the right to exclude granted by a patent. In order to overcome an "obviousness-type" double patenting rejection, an applicant may file a "terminal disclaimer," foregoing that portion of the term

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of the second patent that extends beyond the term of the first.
Berg, 140 F.3d at 1431-32, 46 USPQ2d at 1229.

Thus, if a claim sought in the application is not identical to yet **not patentably distinct** from a claim in an inventor's earlier patent, then the claim must be rejected under "obviousness-type" double patenting rejection. See Berg, 140 F.3d at 1431, 46 USPQ2d at 1229; In re Braat, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1991); Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015; Vogel, 422 F.2d at 441, 164 USPQ at 622. In determining whether a claim sought in the application is **patentably distinct** from the claims in an inventor's earlier patent a variety of tests have been utilized. In Berg, 140 F.3d at 1433-34, 46 USPQ2d at 1230-31 and In re Emert, 124 F.3d 1458, 1461-62, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997), a "one-way" test was applied. Under this "one-way" test, the examiner asks whether the application claims are obvious over the patent claims. In Goodman, 11 F.3d at 1052-53, 29 USPQ2d at 2015-16 and Van Ornum, 686 F.2d at 942-43, 214 USPQ at 766-67, a test similar to the "one-way" test was applied. Under this test, the examiner asks whether the application claims are generic to any species set forth in the patent claims. In In re Dembiczak, 175 F.3d 994, 1002, 50 USPQ2d 1614, 1619-20 (Fed. Cir. 1999) and Braat,

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937 F.2d at 593-94, 19 USPQ2d at 1292-93, a "two-way" test was applied. Under this "two-way" test, the examiner asks whether the application claims are obvious over the patent claims and also asks whether the patent claims are obvious over the application claims.

We recognize that the examiner's rejections are based in large measure on the decision of the court in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).⁵ However, it is our view that Schneller does not set forth another test for determining "obviousness-type" double patenting. In that regard, it is clear to us that the court in Schneller was concerned with whether or not the invention claimed in the patent was **independent and**

⁵ Schneller is a rather unusual case in that there was no majority opinion because only Judges Rich and Smith joined the principal opinion, while Judges Worley and Kirkpatrick concurred in the result and Judge Almond wrote a concurring opinion. Thus, the principal opinion therein is of doubtful controlling precedent. As Judge Rich observed in Kaplan, 789 F.2d at 1578, 229 USPQ at 682,

[t]he development of the modern understanding of "double patenting" began in the Court of Customs and Patent Appeals (CCPA) about the time of In re Zickendraht, 319 F.2d 225, 138 USPQ 22 (CCPA 1963), a rather unusual case is [sic, in] that there was no majority opinion because only two judges joined each of the two principal opinions. Neither opinion therein, therefore, can be regarded as controlling precedent in this court.

distinct from the invention of the appealed claims.⁶ While the court in Schneller did use a "cover" test⁷ in making the determination that the invention claimed in the patent was not **independent and distinct** from the invention of the appealed claims, we are of the view that the term "cover" was used by the court as synonymous with not patentably distinct. Thus, under the "cover" test, one would ask whether the application claims are **covered** by (i.e., not patentably distinct from) the claims of the patent. To the extent that Judge Rich in Schneller was setting forth a domination theory⁸ of double patenting, we note that Judge Rich in Kaplan, 789 F.2d at 1577-78, 229 USPQ at 681-82, set forth the Courts opinion that "[d]omination is an irrelevant fact." In any event, it is our view that Schneller did not establish a rule of general application and thus is limited to the particular set of facts set forth in that

⁶ See Schneller, 397 F.2d at 354, 158 USPQ at 214-15.

⁷ As set forth in the Manual of Patent Examining Procedure (MPEP) § 804, one part of the test is whether patent protection for the invention, fully disclosed in and **covered** by the claims of the reference, would be extended by the allowance of the claims in the later filed application.

⁸ A first patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in the second patent or application.

decision. In fact, the Court in Schneller, 397 F.2d at 355, 158 USPQ at 215, cautioned against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.

Accordingly, the question before us in this appeal is whether the application claims are **patentably distinct** from claim 1 of U.S. Patent No. 5,684,776, claim 1 of U.S. Patent No. 5,703,857; claim 1 of U.S. Patent No. 5,724,331; and claim 1 of copending Application No. 08/482,052.

With respect to the rejections before us, the examiner has stated the following:

While Appellant has presented claims of varying scope such as including the bias coil arm in the instant application, the actual improvement over the prior art centers around the inclined loading and unloading of the disk hub onto the spindle magnet. The other sub-components, such as the bias coil assembly, door links, cartridge receiver latch, and parking arm, which are known in the art per se, have been reconfigured to cooperate with the cartridge loading mechanism and their inclusion (in different permutations) in the claims of the five applications does not create patentably distinct inventions. Therefore, these claims drawn to a single disclosed embodiment of the invention are considered to be mere obvious variant ways of claiming the same invention within the scope of the meaning of the judicially created doctrine of "obviousness-type" double patenting. [Answer, p. 13].

[T]he inventions set forth in the claims of all five applications are all covering the same invention, are all

drawn to obvious variants of the same single disclosed embodiment, and are not independent and distinct from each other. [Answer, p. 42].

It is the Examiner's position that the claims of the instant application, the claims of the three issued patents, and the claims of application 08/482,052 are not independent and distinct. It is notable that throughout the prosecution of the earliest filed application, no requirement for restriction was made, even though claims drawn to the same scope as now found in the later four applications were present, because they were all drawn to the same, single disclosed embodiment of the invention. The public policy considerations underlying 35 U.S.C. 121 permit separate patents on "independent and distinct" inventions which are initially "claimed in one application." [Answer, p. 48].

If ABC and XYZ are independent and distinct inventions, Appellant can choose to only claim ABC in the earlier application and only claim XYZ in a later, voluntarily filed divisional application and the question of obviousness-type double patenting would not apply. The real issues are whether the applicant disclosed a single invention or independent and distinct inventions, and whether the inventor of a single invention should be able, through "artful" claim drafting, to obtain an additional patent term or terms on a single invention. In the instant case, the claims of the issued patents and the copending applications were present in the parent application 08/296,794 (U.S. Patent 5,724,331) and no restriction requirement was made, because the claims were drawn to a single disclosed embodiment of the invention. [Answer, p. 50].

Attached to this decision in Appendix A is a side-by-side analysis of the claims of the instant application and U.S. Patent Nos. 5,684,776; 5,703,857; 5,724,331 and copending application 08/482,052. In this analysis, only the limitations in U.S. Patent Nos. 5,684,776; 5,703,857; 5,724,331 and copending

application 08/482,052 that are not present in the instant application are bold print highlighted.

Our review of the claims under appeal and claim 1 of U.S. Patent No. 5,684,776; claim 1 of U.S. Patent No. 5,703,857; claim 1 of U.S. Patent No. 5,724,331; and claim 1 of copending Application No. 08/482,052 leads us to conclude that, absent the presence of additional evidence not before us in this appeal, the claims under appeal are **patentably distinct** from (1) claim 1 of U.S. Patent No. 5,684,776; (2) claim 1 of U.S. Patent No. 5,703,857; (3) claim 1 of U.S. Patent No. 5,724,331; and (4) claim 1 of copending Application No. 08/482,052. In that regard, from a review of Appendix A it is quite clear that only claims in the present application recite a cartridge loading apparatus having a bias coil arm including a bias coil assembly and a lever arm engageable with a notch formed in one of the first or second sliders as set forth in claim 1 under appeal. Thus, claim 1 and claims 21 to 27 dependent thereon are **patentably distinct** from claim 1 of U.S. Patent No. 5,684,776, claim 1 of U.S. Patent No. 5,703,857; claim 1 of U.S. Patent No. 5,724,331; and claim 1 of copending Application No. 08/482,052 in the absence of any evidence establishing that the claimed bias coil arm was known in the art. While the examiner has stated

that sub-components, such as the bias coil assembly, door links, cartridge receiver latch, and parking arm, are known in the art per se, the examiner has not produced any evidence that the claimed bias coil arm was so much as known in the art, much less that it would have been obvious to add such a bias coil assembly to the inventor's previously claimed subject matter.⁹

In summary, the examiner has failed to establish that the claims under appeal are not patentably distinct from claim 1 of U.S. Patent No. 5,684,776; claim 1 of U.S. Patent No. 5,703,857; claim 1 of U.S. Patent No. 5,724,331; and claim 1 of copending Application No. 08/482,052. Likewise, the examiner has failed to establish that the claims under appeal are obvious from or generic to claim 1 of U.S. Patent No. 5,684,776; claim 1 of U.S. Patent No. 5,703,857; claim 1 of U.S. Patent No. 5,724,331; and claim 1 of copending Application No. 08/482,052. Furthermore, it is our view that the facts of this case are sufficiently different from the facts present in Schneller that a double patenting rejection in this application is inappropriate.

⁹ While the examiner did not require restriction between the claims that were pending in Application No. 08/296,794 (now U.S. Patent 5,724,331), as far as we are able to determine there was no reason why it would not have been proper for the examiner to have made a restriction requirement under the criteria of distinctness set forth in MPEP § 806.05(c).

Accordingly, the decision of the examiner to reject claims 1 and 21 to 27 under the judicially created doctrine of nonstatutory (i.e., obviousness-type) double patenting over claim 1 of U.S. Patent No. 5,684,776, claim 1 of U.S. Patent No. 5,703,857 and claim 1 of U.S. Patent No. 5,724,331 is reversed and the decision of the examiner to provisionally reject claims 1 and 21 to 27 under the judicially created doctrine of nonstatutory double patenting over claim 1 of copending Application No. 08/482,052 is reversed.

To summarize, the decision of the examiner to reject claims 1 and 21 to 27 is reversed.

REVERSED

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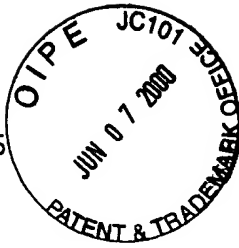
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APPENDIX A

08/486,545	5,724,331	5,703,857	08/482,052	5,684,776
1. A cartridge loading apparatus for use with a disk drive having a cartridge loading end and a remote end,	1. A cartridge loading apparatus in a disk drive having a cartridge loading end, a remote end, and	1. A cartridge loading apparatus for use with a disk drive having a cartridge loading end and a remote end,	1. A cartridge loading apparatus for use with a disk drive having a cartridge loading end and a remote end,	1. A cartridge loading apparatus for use with a disk drive having a cartridge loading end and a remote end,
said cartridge loading apparatus comprising:	said cartridge loading apparatus comprising:	said cartridge loading apparatus comprising:	said cartridge loading apparatus comprising:	said cartridge loading apparatus comprising:
a base plate having a first slider channel and a second slider channel;	a base plate, having a first slider channel and a second slider channel;	a base plate having a first slider channel and a second slider channel;	a base plate having a first slider channel and a second slider channel;	a base plate having a first slider channel and a second slider channel;
at least one door link rotatably attached to said base plate, said at least one door link having a free contact end;	at least one door link rotatably attached to said base plate, said at least one door link having a free contact end;	at least one door link rotatably attached to said base plate, said at least one door link having a free contact end and a latch-release trip lug;	at least one door link rotatably attached to said base plate, said at least one door link having a free contact end and a latch-release trip lug;	at least one door link rotatably attached to said base plate, said at least one door link having a free contact end and a latch-release trip lug;



08/486,545

5,724,331

5,703,857

08/482,052

5,684,776

means for
slidably supporting
a fine actuator
assembly carriage
relative to said base
plate for movement
over an
information
storage disk having
a central hub;
a parking arm rotatably
secured to said
base plate above a
parking arm axis,
said parking arm
including a linking
end and a pressing
end for acting upon
the fine actuator
assembly carriage;

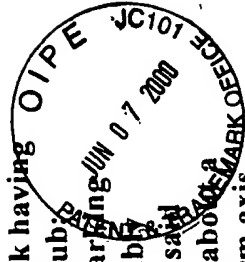
a first slider
slidably associated
with said first slider
channel, said first
slider having a
forward end adjacent
the cartridge loading
end of the disk drive

a first slider
having a forward
end adjacent the
cartridge loading end
of the disk drive

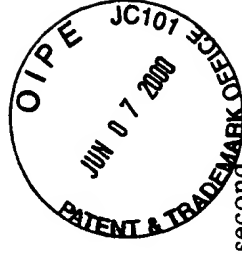
a first slider
slidably **contained**
within said first
slider channel, said
first slider having a
forward end adjacent
the cartridge loading
end of the disk drive

a first slider
slidably **contained**
within said first
slider channel, said
first slider having a
forward end adjacent
the cartridge loading
end of the disk drive

a first slider
slidably associated
with said first slider
channel, said first
slider having a
forward end adjacent
the cartridge loading
end of the disk drive



08/486,545	and a remote end adjacent the remote end of the disk drive;	5,724,331	and a remote end adjacent the remote end of the disk drive;	5,703,857	and a remote end adjacent the remote end of the disk drive;	08/482,052	and a remote end adjacent the remote end of the disk drive;	5,684,776	and a remote end adjacent the remote end of the disk drive;
		said first slider further having only one S-shaped slot formed therein to provide a first low-resistance linking connection;		said first slider having only one S-shaped slot formed therein;					
a second slider slidably associated with said second slider channel, said second slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive;		a second slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive;		a second slider slidably contained within said second slider channel, said second slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive;		a second slider slidably contained within said second slider channel, said second slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive;		a second slider slidably associated with said second slider channel, said second slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive, one of said first and second sliders having lug means formed thereon for engaging said linking end of said	

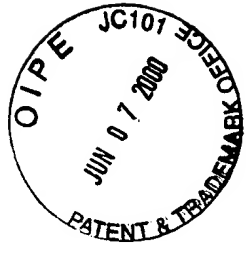


08/486,545 5,724,331 5,703,857 08/482,052 5,684,776

parking arm;

said second
slider having only
one S-shaped slot
formed herein;

one of said
first and second
sliders having a
notch formed
therein;
a bias coil
arm rotatably
secured to said base
plate, said bias coil
arm including a bias
coil assembly and
having a lever arm
extending therefrom,
said lever arm being
engageable with said
notch in said one of
said first and second
sliders so that when
said one slider is
activated, said bias
coil arm turns to
correspondingly
position the bias coil



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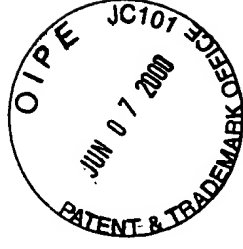
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assembly relative to
an information
storage disk having a
central hub;

said second
slider further
having only one S-
shaped slot formed
therein to provide
a second low-
resistance linking
connection;



a tiller having
a first end and a
second end, said first
end of said tiller
being swingably
associated with said
forward end of said
first slider, and said
second end of said
tiller being
swingably associated
with said forward
end of said second
slider, so that a first
rotation of said

a tiller having
a first end and a
second end, said first
end of said tiller
being swingably
linked with said
forward end of said
first slider, and said
second end of said
tiller being swingably
linked with said
forward end of said
second slider, so that
a first rotation of
said tiller in a

a tiller having
a first end and a
second end, said first
end of said tiller
being swingably
associated with said
forward end of said
first slider, and said
second end of said
tiller being swingably
associated with said
forward end of said
second slider, so that
a first rotation of
said

a tiller having
a first end and a
second end, said first
end of said tiller
being swingably
associated with said
forward end of said
first slider, and said
second end of said
tiller being swingably
associated with said
forward end of said
second slider, so that
a first rotation of
said

a tiller having
a first end and a
second end, said first
end of said tiller
being swingably
associated with said
forward end of said
first slider, and said
second end of said
tiller being swingably
associated with said
forward end of said
second slider, so that
a first rotation of
said

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tiller in a first direction about a tiller axis drives said first slider toward the cartridge loading end of the disk drive while driving said second slider toward the remote end of the disk drive, and a second rotation of said tiller in a second direction about said tiller axis drives said first slider toward the remote end of the disk drive while driving said second slider toward the cartridge loading end of the disk drive;

first direction about a tiller axis drives said first slider toward the cartridge loading end of the disk drive while driving said second slider toward the remote end of the disk drive, and a second rotation of said tiller in a second direction about said tiller axis drives said first slider toward the remote end of the disk drive while driving said second slider toward the cartridge loading end of the disk drive;

tiller in a first direction about a tiller axis drives said first slider toward the cartridge loading end of the disk drive while driving said second slider toward the remote end of the disk drive, and a second rotation of said tiller in a second direction about said tiller axis drives said first slider toward the remote end of the disk drive while driving said second slider toward the cartridge loading end of the disk drive;

tiller in a first direction about a tiller axis drives said first slider toward the cartridge loading end of the disk drive while driving said second slider toward the remote end of the disk drive, and a second rotation of said tiller in a second direction about said tiller axis drives said first slider toward the remote end of the disk drive while driving said second slider toward the cartridge loading end of the disk drive;

tiller in a first direction about a tiller axis drives said first slider toward the cartridge loading end of the disk drive while driving said second slider toward the remote end of the disk drive, and a second rotation of said tiller in a second direction about said tiller axis drives said first slider toward the remote end of the disk drive while driving said second slider toward the cartridge loading end of the disk drive;

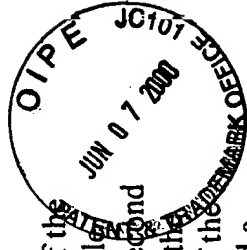
a cartridge receiver for receiving a respective cartridge containing the disk, said cartridge

a cartridge receiver for receiving a respective cartridge containing a disk with a central hub,

a cartridge receiver for receiving a respective cartridge containing a disk with a central hub

a cartridge receiver for receiving a respective cartridge containing a disk with a central hub

a cartridge receiver for receiving a respective cartridge containing the disk, said cartridge



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receiver being linked to said first and second sliders and tiltably moveable between an upper position and a lower position along a vertical path when said sliders are driven by said tiller;

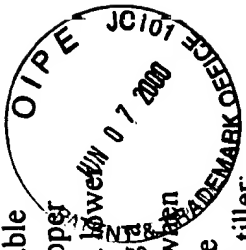
said cartridge receiver being linked to said first and to said second slider by their respective S-shaped slots and moveable between an upper position and a lower position when said sliders are driven by said tiller;

and at least one shutter door covering the disk, said cartridge receiver being linked to each of said first and second sliders by the corresponding only one S-shaped slot formed respectively therein and moveable between an upper position and a lower position along a non-horizontal path when said sliders are driven by said tiller;

and at least one shutter door covering the disk, said cartridge receiver being linked to said first and second sliders and moveable between an upper position and a lower position along a vertical path while tilting when said sliders are driven by said tiller;

receiver being linked to said first and second sliders and tiltably moveable between an upper position and a lower position along a vertical path when said sliders are driven by said tiller;

a stop cooperative with said cartridge receiver, said stop for preventing said cartridge receiver from further movement when the disk is fully loaded;
drive means



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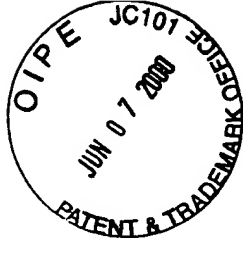
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for providing a
controllable force
to said tiller so that
the tiller is
controllably
rotated about said
tiller axis;
a gear train
interposed between
said drive means
and said tiller, said
gear train directly
transmitting said
controllable force
provided by said
drive means, said
gear train thereby
providing an
efficient transfer of
said controllable
force; and

a receiver
latch rotatably
attached to said
base plate, said
receiver latch
engaging said
second slider and
holding said second
slider in a



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rearward position
while said first and
second sliders place
said cartridge
receiver in said
upper position,
said latch-release
trip lug of said at
least one door link
being aligned to
engage said
receiver latch when
said at least one
door link is moved
toward said
receiver latch to
disengage said
receiver latch from
said second slider
so that said second
slider may be
moved forward to
place said cartridge
receiver in said
lower position; and

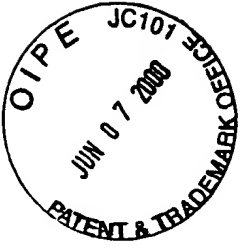
a cam
operatively
associated with said

a cam operatively
associated with said
tiller and said gear

a cam
operatively
associated with said

a cam
operatively
associated with said

a cam
operatively
associated with said



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tiller for rotating
said tiller about said
tiller axis so that
when said first and
second sliders move
said cartridge
receiver between
said upper and lower
positions, said
cartridge receiver,
respective cartridge,
and disk move along
said vertical path so
that the central hub
is inclined relative to
a spindle magnet for
loading and
unloading the disk
thereon to thereby
reduce the force
needed to remove
the central hub from
the spindle magnet
while coordinating
movement of the
bias coil assembly
with the disk.

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train for rotating
said tiller about said
tiller axis so that
when said first and
second sliders move
said cartridge
receiver between
said upper and lower
positions, said
cartridge receiver,
respective cartridge,
and disk move along
a **non-horizontal**
path while tilting
to thereby reduce
the force needed to
remove the central
hub from a spindle
magnet while said
first and second
low-resistance
linking connections
provided by the
respective S-shaped
slots further
contribute to
reducing the force
needed to drive
said first and
second sliders.

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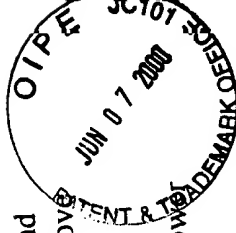
tiller for rotating
said tiller about said
tiller axis so that
when said first and
second sliders move
said cartridge
receiver between
said upper and lower
positions, said
cartridge receiver,
respective cartridge,
and disk move along
said **non-horizontal**
path so that the
central hub is
caused to be
inclined relative to a
spindle magnet, said
at least one door
link being aligned
to engage the
shutter door when
said respective
cartridge is
inclined and
moving along said
non-horizontal
path, said inclined
positioning of the

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tiller for rotating
said tiller about said
tiller axis so that
when said first and
second sliders move
said cartridge
receiver between
said upper position
and said lower
position, said
cartridge receiver,
respective cartridge,
and disk move along
said vertical path so
that the central hub
is **caused to be**
inclined relative to a
spindle magnet, said
at least one door
link being aligned
to engage the
shutter door when
said respective
cartridge is
inclined and
moving along said
vertical path, said
inclined positioning
of the disk thereby
reducing the force

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tiller for rotating
said tiller about said
tiller axis so that
when said first and
second sliders move
said cartridge
receiver between
said upper and lower
positions, said
cartridge receiver,
respective cartridge,
and disk move along
said vertical path so
that the central hub
is inclined relative to
a spindle magnet for
loading and
unloading the disk
thereon thereby
reducing the force
needed to remove
the central hub from
the spindle magnet
while coordinating
movement of the
fine actuator
assembly carriage
by interaction of
said parking arm
with said one of



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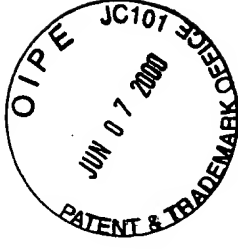
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disk thereby
reducing the force
needed to remove
the central hub from
the spindle magnet
while the disk is
moved between
said upper and
lower positions.

needed to remove
the central hub from
the spindle magnet
while the disk is
moved between
said upper and
lower positions.

said first and
second sliders; and



a jaw
member positioned
proximate said
linking end of said
parking arm, said
jaw member

having a first side
and a second side
which straddle said
lug means so that
when said one
slider is moved
toward the
cartridge loading
end of the disk

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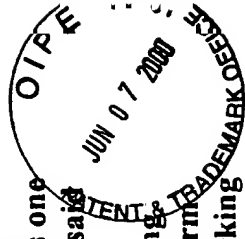
drive, said lug means engages one of the sides of said jaw member thereby rotating said parking arm about said parking axis so that the pressing end of said parking arm acts against the fine actuator assembly carriage which is thereby moved away from the cartridge loading end of the disk drive allowing said respective cartridge to be loaded therein.

21. The cartridge loading apparatus according to claim 1 wherein the maximum distance

21. The cartridge loading apparatus according to claim 1 wherein the maximum distance

21. The cartridge loading apparatus according to claim 1 wherein the maximum distance

21. The cartridge loading apparatus according to claim 1 wherein the maximum distance



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between said upper position and said lower position of said cartridge receiver is approximately 5 mm.

between said upper position and said lower position of said cartridge receiver is approximately 5 mm.

between said upper position and said lower position of said cartridge receiver is approximately 5 mm.

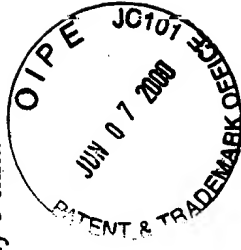
between said upper position and said lower position of said cartridge receiver is approximately 5 mm.

Claims 22-27 are drawn to further defining the bias coil assembly.

Claims 4-6 are drawn to defining a parking arm associated with the sliders.

Claim 24 is similar to claim 1 except that it specifies the movement of the parking arm for releasing the fine actuator assembly carriage.

Claim 8 is similar to claim 1 while further specifying lifting pins of a cartridge receiver.



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Claim 20 is drawn to a method of manufacturing the apparatus.

Claim 23 is similar to claim 8.

Claims 24 and 25 are drawn to a method of loading and unloading a disk cartridge.

Claims 26 and 27 are further drawn to specifying a skirt portion of the tiller.

Claims 22-27 are further drawn to the door links and door link stops.

Claim 28 further specifies electric ejection means for rotating

Claim 26 is drawn to electric ejection means for rotating the tiller.



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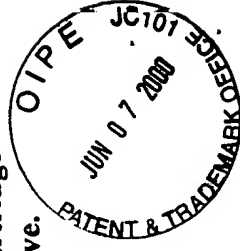
the tiller.

Claim 7 is
drawn to a label of
the cartridge
remaining visible
when the cartridge
is in the drive.

Claim 30 is
drawn to a label of
the cartridge
remaining visible
when the cartridge
is in the drive.

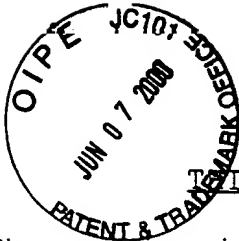
Claim 31 is
drawn to lifting
pins of the
cartridge receiver
and specifies their
position.

Claim 27 is
drawn to a label of
the cartridge
remaining visible
when the cartridge
is in the drive.



Claims 22-
26 are further
drawn to the
receiver latch.

Claim 25 is drawn
to a manually
operated ejection
button that moves
one of the sliders.



THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 39

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Step toe & Johnson LLP

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE R. DAKIN

Appeal No. 1999-1447
Application 08/446,316

HEARD: March 22, 2000

MAILED

MAY 9 2000

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before STONER, Chief Administrative Patent Judge, and HAIRSTON
and Nase, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

This is an appeal from the final rejection of claims 43 and
45 through 54.

The disclosed invention relates to a method and apparatus
for reproducing information from a disc. An active squelch
signal is used to prevent output of audio information at distinct
times.

Claims 45 and 49 are illustrative of the claimed invention, and they read as follows:

45. A disc playing apparatus for reproducing information from a disc storing at least video picture information and audio information corresponding to the video picture information, and receiving a combined video/audio information signal from the disc indicative of both said video picture information and said audio information, said apparatus comprising:

a sequence controlling element, receiving said combined video/audio information signal, and determining at specific times whether the contents of said video/audio information signal are representative of audio or video and producing a first signal indicative of audio being present, said sequence controlling element further producing a second, squelch signal, said squelch signal being in an active state for a time period at least on the order of one-tenth second and transitioning to said active state at least partially at distinct times from transitions of said first signal;

an audio processing circuit, receiving said combined audio/video signal, and receiving said first signal from said sequence controlling element indicative of audio being present, and, when said first signal indicates that audio is present, processing the audio signal to produce an output indicative of the audio signal; and

said audio processing circuit receiving said squelch signal, and preventing output of audio information when said squelch signal is active.

49. A method for reproducing information from an information-containing disc having at least video picture information and audio information corresponding to the video picture information recorded thereon, comprising the steps of:

scanning the disc to produce a combined video/audio information signal from the disc indicative of both video picture information and audio;

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Application No. 08/446,316

determining at specific times, whether contents of said video/audio information signal are representative of audio or video;

producing a first signal indicative of audio being present;

producing a second squelch signal active at least partially, and for a time period at least on the order of one-tenth second, at distinct times from said first signal;

processing said combined audio/video signal in an audio processing circuit responsive to said first signal indicative of audio being present, to produce an output indicative of the audio signal; and

preventing output of audio information when said squelch signal is active.

The references relied on by the examiner are:

Newell	3,789,137	Jan. 29, 1974
Dakin	4,583,131	Apr. 29, 1986
	(effective filing date of Aug. 15, 1979)	
Nakagawa et al. (Nakagawa)	4,809,118	Feb. 28, 1989
		(filed Apr. 22, 1986) ¹

Claims 43 and 45 through 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Newell.

Claims 43 and 45 through 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Newell in view of Nakagawa.

Claims 43 and 45 through 54 stand rejected "under the judicially created doctrine of double patenting over claims 1-12

¹Appellant has not challenged the interjection of a Continuation-in-Part (CIP) application in the continuation chain back to July 16, 1979.

of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" (Answer, page 3).

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

The rejections of claims 43 and 45 through 54 are reversed.

Turning first to the obviousness rejections, appellant argues (Brief, page 6) that:

Neither Newell nor Nakagawa teach or suggest the claimed squelch signal in the record disc playback apparatus of the type recited in the appealed claims. Newell discloses [Figure 13] a control line connecting code recognition circuit 210 (sic) to switch 210 (sic) and the rejection of Paper 26 infers that a signal on that line distinguishes audio data from visual data in a signal being recovered from a disc. That signal may be active (i.e., indicate presence of visual data) for a single frame, which Newell suggests would be for about 33 milliseconds. Assuming for the sake of argument that one of ordinary skill would substitute the Nakagawa data circuits 141-142 [Figure 19] for the Newell switch 210 (sic), and also assuming that one of ordinary skill would provide the Nakagawa Gate Signal Generator at the output of the Newell code recognition circuit 210 (sic), the result would not be a squelch signal. The result would be a way to divide every third element of a single signal (being recovered from a disc) to either a video refresh memory or an audio expansion circuit. For the sake of argument, the circuit could be modified to be more suitable to the intended function of the switch 210(sic), and route an entire video frame to the video refresh memory 212. Such a modification might arguably produce a signal

comparable to the claimed first signal, which would indicate (to the switch 210 (sic) the presence of audio data in a combined video/audio signal being scanned from the disc. However, such a combination would not produce a signal comparable to the second squelch signal.

We agree with appellant's arguments. Thus, the obviousness rejections of claims 43 and 45 through 54 are reversed because "neither Newell nor Newell in combination with Nakagawa provides a basis for the section 103(a) rejections of the appealed claims, . . ." (Brief, page 23).

Turning next to the double patenting rejection, the examiner's statement of the rejection (Examiner's Answer, pages 3 through 5) is reproduced in toto as follows:

Claims 43 and 45-54 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a disc playing apparatus for reproducing information from a disc storing at least video picture information and audio information having means for scanning the disc to produce the picture information and the audio information and a memory for storing the audio signal outputted from the scanning means. The subject matter recited in claims 43 and 45-54 of this patent application- "comprising ABCY" - is fully disclosed in the patent 4,583,131. The allowance of these claims would extend the rights [sic] to exclude

already granted in claims 1-12 of the patent - that right to exclude covering the device "comprising ABCX". The transitional phrase "comprising" does not exclude the presence of elements other than A, B, C, and X in the claims of the patent. Because of the phrase "comprising" the patent claims not only provides [sic] protection to the elements ABCX claimed in the patent but also extends [sic] patent coverage to the disclosed combination - ABCXY. Likewise, if allowed, the claims of this application, because of the phrase comprising, not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY - already disclosed and covered by the claims in the patent. Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in this application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).^[2] See also MPEP § 804.

2nd part
of Schneller
text

²The examiner's rationale for the rejection tracks the reasoning used by the court which is as follows:

While his [Schneller's] invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming BCX and ABCX, but so claiming these combinations as to cover them no matter what other feature is incorporated in them, thus covering effectively ABCXY. He now, many years later, seeks more claims directed to ABCX and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the

(continued...)

In response to the examiner's Schneller-based rejection, appellant argues (Brief, pages 7 through 17) that Schneller has been overruled by subsequent cases. According to appellant (Brief, page 8), the Court of Customs and Patent Appeals (CCPA) overruled Schneller in In re White, 405 F.2d 904, 906, 160 USPQ 417, 418 (CCPA 1969) by stating "[o]f course, if the appealed invention is unobvious, there can be no double patenting." In White, the CCPA made such statement in connection with nonobviousness under 35 U.S.C. § 103, and not in connection with same invention double patenting under 35 U.S.C. § 101 or the judicially-created, obviousness-type double patenting. The Schneller decision never mentioned "nonobviousness" type double patenting, and the White decision was not addressing the same.³ Thus, the Court had no need to overrule that which it had not created.

²(...continued)
expiration of his patent, were we to reverse.
Schneller, 397 F.2d at 355-56, 158 USPQ at 216.

³The so-called "nonobviousness" type of double patenting was a creation of the U.S. Patent & Trademark Office. See Manual of Patent Examining Procedure (MPEP) § 804 (6th ed., Jan. 1995), pages 800-15 and 800-16. The latest edition of the MPEP has dropped "nonobviousness" from the description of the Schneller decision.

Appellant argues (Brief, page 8) that the Court sitting en banc in In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 621 (CCPA 1970) overruled prior CCPA decisions, such as Schneller, to the extent that the prior decisions were inconsistent therewith. Schneller was not mentioned in Vogel.

Although the subsequent case of In re Kaplan, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) dealt with an obviousness-type, double patenting rejection, it does not support appellant's arguments (Brief, page 8) because the Court never mentioned Schneller.

Thus, appellant's arguments to the contrary notwithstanding, Schneller did not create a third type⁴ of double patenting rejection (i.e., nonobviousness-type double patenting rejection) (Brief, pages 9 and 10).

Appellant argues (Brief, page 15) that "in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992), the Federal Circuit reiterated that 'same invention' and 'obvious-type' are the only recognized bases for a double patenting rejection." We agree

⁴As indicated supra, the judicially-created, obviousness-type double patenting and same invention double patenting under 35 U.S.C. § 101 are the only types of double patenting rejections.

with appellant's argument. Schneller fits within the latter type of double patenting rejection, and a "Schneller-based double patenting [rejection] is legally viable" (Brief, page 11).

Appellant argues (Brief, page 18) that "[i]f Schneller was good law, why did the U.S.P.T.O. fail to apply it between 1970 and 1994?" The mere fact that the Office failed to rely on Schneller until it was addressed in the 6th edition of the MPEP does not affect the use of Schneller as a basis for instituting a double patenting rejection when the facts in an application support such a rejection. When Schneller is properly applied, it will not "cast doubt over the validity of an untold number of issued patents, create disputes, and invite litigation" (Brief, page 18).

According to appellant (Brief, page 20), "[t]he second step of the Schneller-based double patenting analysis inquires whether there was a reason why an applicant was prevented from presenting the later-examined claims in the prior application." Appellant argues (Brief, page 20) that he "was indeed prevented from doing so by operation of Title 37, Code of Federal Regulation, section

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1.141" which "prevents an applicant from claiming two or more 'independent and distinct' inventions in a single application."

A limitation-by-limitation comparison of the claims on appeal to the claims in the patent is needed to determine whether the two sets of claims present "independent and distinct" inventions. The examiner has not made a "side by side comparison of the reference and application claims." See MPEP § 804 II B(2), page 800-21. Notwithstanding the lack of such an analysis by the examiner, the Court has indicated that appellant should establish that "the invention claimed in his patent is independent and distinct⁽⁵⁾ from the invention of the appealed claims." Schneller, 397 F.2d at 354, 158 USPQ at 214.

Accordingly, appellant argues (Brief, page 22) that:

It is clear that the appealed claims and the claims of the '131 patent do not form a single general inventive concept.⁽¹⁸⁾ The appealed claims recite apparatuses and methods relating to the reproduction of information from a disc. The subject matter of the appealed claims forms a general inventive concept different from that of the inventions defined by the claims of the '131 patent for the following reasons: Each of the appealed claims recites a device or step for producing and processing a first signal indicative

⁵In other words, a determination has to be made whether there is a "patentable difference" or a "patentable distinction" between the claims of the patent and the claims on appeal. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278-79, 23 USPQ2d 1839, 1844 (Fed. Cir. 1992).

of audio being present and a second, squelch signal which indicates that no audio is present. The general inventive concept defined by the appealed claims allows the signal output from the devices and methods claimed therein to prevent any audio output from being produced while the squelch signal is active. That same general inventive concept is not present in any of the claims of the '131 patent.

Because the appealed claims recite a general inventive concept different from that of the claims of the '131 patent, Applicant was prevented from presenting the appealed playback claims for examination in the application that issued into the '131 patent in 1985-86. Thus, step 2 of the *Schneller*-based double patenting test is not satisfied with respect to the appealed claims, and the rejection of those claims should be withdrawn.

A limitation-by-limitation comparison of the independent claims in the patent to the independent claims in the application is provided infra. To aid in this comparison, the following alphabetical designation has been provided for each signal and element that is claimed in both the patent claims and the application claims:

CLAIMED SIGNAL OR ELEMENT

ALPHABETICAL DESIGNATION

1. Video signal 35	A
2. Audio signal 21	B
3. Memory 31	C
4. Adaptive Delta Demodulator 23	D
5. Low-Pass Filter 51	E
6. Video Normalizer 55	F
7. Summer 59	G
8. Video/Data Output Signal 61	H
9. Disc Mastering Machine/Disc Reproduction Apparatus	I

Appeal No. 1999-1447
Application No. 08/446,316

10. Video/Data Input Signal 65	J
11. Data Normalizer 67	K
12. Memory 77	L
13. Adaptive Delta Demodulator 99	M
14. Analog Audio Output Signal 101	N
15. Video Output From Disc Reproduction Apparatus	O
16. Chroma Burst Timing Signal 72	P
17. Vertical Blanking Signal 85	Q
18. Horizontal Blanking Signal 87	R
19. Playback Apparatus (Audio/Video)	S
20. Data Flag Signal 73	T
21. Sequence Controller 69	U
22. 7.2 MHZ Enable Signal 75	V
23. Clock Generator 71	W
24. AND gate 83	X
25. Squelch signal 103	Y
26. Record Disc	Z

In the following limitation-by-limitation comparison of independent claims 1, 6, 7 and 12 in the patent to independent claims 45 and 49 in the application, the above-noted alphabetical designations are used for each of the claimed signals or elements. A bold-typed alphabet in the application claims indicates that the signal or element is not in the patent claims:

U.S. PATENT NO. 4,583,131

Claim 1 - IJLMNOSZ
Claim 6 - IJLMNOPQRSZ
Claim 7 - IJLMNOSZ
Claim 12- IJLMNOPQRSZ

APPLICATION CLAIMS

Claim 45 - IJNUVWYZ
Claim 49 - IJNUVWYZ

From the comparison, it is clearly seen that each of the independent application claims 45 and 49 includes inter alia a first signal indicative of audio being present, and a second

signal (i.e., a squelch signal) that is distinct from the first signal, and that is active for a time period at least on the order of one-tenth second. When the squelch signal is active, the application claims prevent the output of audio information. The examiner has not explained how the application claims with this feature could have been presented at the time of prosecution of the patent claims, or how this claimed subject matter is "covered" by the patent claims no matter what other feature is incorporated in them. It would have been equally helpful for an explanation by the examiner as to why no other evidence of obviousness was needed beyond the claims of the patent. In the absence of such a showing or a convincing line of reasoning by the examiner, we agree with the appellant that the added feature(s) in these application claims "is not present in any of the claims of the '131 patent" (Brief, page 22), and that these claims are "independent and distinct" inventions (Brief, page 20). Stated differently, we agree with the appellant that the inclusion of the squelch signal (i.e., signal Y) in the method and apparatus claims for reproducing information from a disc produced an invention IJNUVWYZ that is patentably distinct from the invention IJLMNOSZ and IJLMNOPQRSZ set forth in the patent based upon the evidence of record. As a result of the patentable

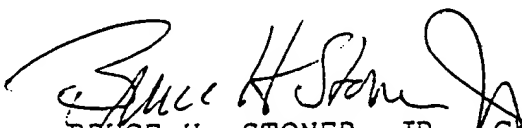
Appeal No. 1999-1447
Application No. 08/446,316

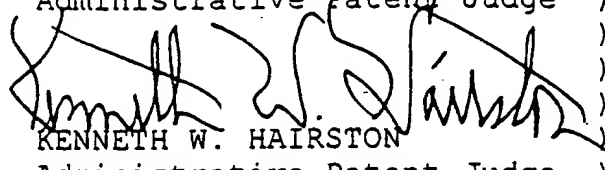
distinctness between the application claims and the patent claims, the examiner could have made a restriction requirement in the originally filed application.

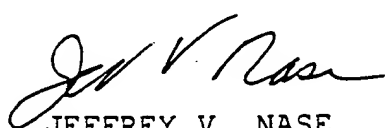
DECISION

In summary, the obviousness rejections of claims 43 and 45 through 54 are reversed, and the judicially created doctrine of double patenting rejection of claims 43 and 45 through 54 is reversed.

REVERSED


BRUCE H. STONER, JR., Chief
Administrative Patent Judge


KENNETH W. HAIRSTON
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

KWH:svt

Appeal No. 1999-1447
Application No. 08/446,316

STEPTOE & JOHNSON LLP
1330 Connecticut Avenue, N.W.
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Attention: Stuart T. F. Huang



THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

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Steptoe & Johnson LLP

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE R. DAKIN

Appeal No. 1999-0189
Application 08/344,691

HEARD: March 22, 2000

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before STONER, Chief Administrative Patent Judge, and HAIRSTON
and Nase, Administrative Patent Judges.

Hairston, Administrative Patent Judge.

This is an appeal from the final rejection of claims 42
through 51, 53 through 59 and 61.

The disclosed invention relates to a method and apparatus
for producing a signal used for forming a record disc which
stores segments of audio information and corresponding segments
of video information, and to a method and apparatus for

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reproducing information from a disc which has data recorded thereon of a type which includes a frame of a video signal which is displayed while an audio portion is played.

Claims 42 and 45 are illustrative of the claimed invention, and they read as follows:

42. An apparatus for producing a signal used for forming a record disc which stores segments of audio information and corresponding segments of video information, comprising:

means for receiving a video signal to be recorded and an audio signal to be recorded;

a memory for storing said audio signal during recording;

a video normalizer, receiving an output of said memory, and adjusting a level of said output of said memory to produce a normalized signal which is adjusted relative to a level of said video signal, thereby utilizing a full dynamic range of video circuitry; and

means for combining said normalized signal indicative of audio with said video signal to produce a composite normalized signal.

45. An apparatus for reproducing information from a disc which has data recorded thereon of a type which includes a frame of a video signal which is displayed while an audio portion is played, comprising:

an element which scans said disc to obtain a combined video/data signal, said video/data signal having a video portion and an audio portion normalized relative to said video portion;

an audio normalizer, receiving said video/data signal, adjusting a level of said video/data signal to produce a normalized signal which utilizes a full dynamic range of audio circuitry;

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a memory, operatively connected to receive at least a part of said combined video/data signal as normalized by said audio normalizer; and

a data converter, operatively coupled to an output of said memory means, reading out audio information from said memory.

Claims 42 through 51, 53 through 59 and 61 stand rejected "under the judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" (Answer, page 3).

Reference is made to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

The rejection of claims 42 through 51, 53 through 59 and 61 is reversed.

The examiner's statement of the rejection (Examiner's Answer, pages 3 through 5) is reproduced in toto as follows:

Claims 42-51, 53-59, and 61 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U.S. Patent No. 4,583,131 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an apparatus for reproducing information form [sic, from] a disc which has data recorded thereon of a

type which includes a frame of a video signal is display [sic] while an audio portion is played having an element which scans the disc to obtain a combined video/data signal, the video/data signal having a video portion and an audio portion; a memory, operatively connected to receive at least a part of the combined video/data signal; and a data converter, operatively coupled to an output of the memory means, reading out audio information form [sic, from] the memory. The subject matter recited in claims 42-62 of this patent application - "comprising ABCY" - is fully disclosed in the patent 4,583,131. The allowance of these claims would extend the rights [sic] to exclude already granted in claims 1-12 of the patent - that right to exclude covering the device "comprising ABCX". The transitional phrase "comprising" does not exclude the presence of elements other than A, B, C, and X in the claims of the patent. Because of the phrase "comprising" the patent claims not only provides [sic] protection to the elements ABCX claimed in the patent but also extends [sic] patent coverage to the disclosed combination - ABCXY. Like wise [sic], if allowed, the claims of this application, because of the phrase comprising, not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY - already disclosed and covered by the claim in the patent. Thus, the controlling fact is that patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in this application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).⁽¹⁾ See also MPEP § 804.

¹The examiner's rationale for the rejection tracks the reasoning used by the court which is as follows:

(continued...)

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Application No. 08/344,691

In response to the examiner's Schneller-based rejection, appellant argues (Brief, pages 4 through 14) that Schneller has been overruled by subsequent cases. According to appellant (Brief, page 4), the Court of Customs and Patent Appeals (CCPA) overruled Schneller in In re White, 405 F.2d 904, 906, 160 USPQ 417, 418 (CCPA 1969) by stating "[o]f course, if the appealed invention is unobvious, there can be no double patenting." In White, the CCPA made such statement in connection with nonobviousness under 35 U.S.C. § 103, and not in connection with same invention double patenting under 35 U.S.C. § 101 or the judicially-created, obviousness-type double patenting. The Schneller decision never mentioned "nonobviousness" type double

¹(...continued)
While his [Schneller's] invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming BCX and ABCX, but so claiming these combinations as to cover them no matter what other feature is incorporated in them, thus covering effectively ABCXY. He now, many years later, seeks more claims directed to ABCX and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse. Schneller, 397 F.2d at 355-56, 158 USPQ at 216.

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patenting, and the White decision was not addressing the same.²
Thus, the Court had no need to overrule that which it had not created.

Appellant argues (Brief, page 4) that the Court sitting en banc in In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 621 (CCPA 1970) overruled prior CCPA decisions, such as Schneller, to the extent that the prior decisions were inconsistent therewith.

Schneller was not mentioned in Vogel.

Although the subsequent case of In re Kaplan, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) dealt with an obviousness-type double patenting rejection, it does not support appellant's arguments (Brief, page 4) because the Court never mentioned Schneller.

Thus, appellant's arguments to the contrary notwithstanding, Schneller did not create a third type³ of double patenting

²The so-called "nonobviousness" type of double patenting was a creation of the U.S. Patent & Trademark Office. See Manual of Patent Examining Procedure (MPEP) § 804 (6th ed., Jan. 1995), pages 800-15 and 800-16. The latest edition of the MPEP has dropped "nonobviousness" from the description of the Schneller decision.

³As indicated supra, the judicially-created, obviousness-type double patenting and same invention double patenting under 35 U.S.C. § 101 are the only types of double patenting rejections.

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Application No. 08/344,691

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rejection (i.e., nonobviousness-type double patenting rejection) (Brief, pages 5 and 6).

Appellant argues (Brief, page 11) that "in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992), the Federal Circuit reiterated that 'same invention' and 'obvious-type' are the only recognized bases for a double patenting rejection." We agree with appellant's argument. Schneller fits within the latter type of double patenting rejection, and a "Schneller-based double patenting [rejection] is legally viable" (Brief, page 6).

Appellant argues (Brief, page 12) that "[i]f Schneller was good law, why did the U.S.P.T.O. fail to apply it between 1970 and 1994?" The mere fact that the Office failed to rely on Schneller until it was addressed in the 6th edition of the MPEP does not affect the use of Schneller as a basis for instituting a double patenting rejection when the facts in an application support such a rejection. When Schneller is properly applied, it will not "cast doubt over the validity of an untold number of issued patents, create disputes, and invite litigation" (Brief, page 13).

According to appellant (Brief, page 14), "[t]he second step of the Schneller-based double patenting analysis inquires whether

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Application No. 08/344,691

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there was a reason why an applicant was prevented from presenting the later-examined claims in the prior application." Appellant argues (Brief, page 14) that he "was indeed prevented from doing so by operation of Title 37, Code of Federal Regulation, section 1.141" which "prevents an applicant from claiming two or more 'independent and distinct' inventions in a single application."

A limitation-by-limitation comparison of the claims on appeal to the claims in the patent is needed to determine whether the two sets of claims present "independent and distinct" inventions. The examiner has not made a "side by side comparison of the reference and application claims." See MPEP § 804 II B(2), page 800-21. Notwithstanding the lack of such an analysis by the examiner, the Court has indicated that appellant should establish that "the invention claimed in his patent is independent and distinct"⁴ from the invention of the appealed claims." Schneller, 397 F.2d at 354, 158 USPQ at 214. Accordingly, appellant argues (Brief, pages 16 and 17) that:

It is clear that the appealed claims and the claims of the '131 patent do not form a single general

⁴In other words, a determination has to be made whether there is a "patentable difference" or a "patentable distinction" between the claims of the patent and the claims on appeal. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278-79, 23 USPQ2d 1839, 1844 (Fed. Cir. 1992).

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inventive concept.⁽¹⁵⁾ For example, the appealed recording claims relate to an apparatus and method of producing a signal used for forming a record disc. In contrast, claims 1-6 of the '131 patent recite an apparatus for playing a record disc, and claims 7-12 of that patent recite a method for playing a record disc. Clearly then, an apparatus and method for producing signals that are used to form a record disc and an apparatus and method for playing a record disc do not form a single general inventive concept. A recording device and method produce signals used for storing information on the record disc. In contrast, a playback device and method is directed to a different general inventive concept -- i.e., the recovery of information stored on the disc.

The different general inventive concepts claimed in the appealed recording claims and the claims of the '131 patent are further exemplified by the disparate language recited in those groups of claim[s]. For example, the apparatuses and methods recited in the appealed recording claims are directed to devices and steps for receiving a video signal to be recorded and an audio signal to be recorded. Clearly, no such devices or steps are required in playing back information from a disc.

Because the appealed recording claims recite a general inventive concept different from that of the claims of the '131 patent, Applicant was prevented, by operation of 37 C.F.R. § 1.141 (1985), from presenting the appealed recording claims for examination during prosecution of the '131 patent in 1985-86. Thus, step 2 of the Schneller-based double patenting test is not satisfied with respect to the appealed recording claims, and the rejection of those claims should be withdrawn.

Similarly, the appealed playback claims (Claims 45, 46, 50, 51, 54, 56 and 58) recite apparatuses and methods relating to the reproduction of information from a disc. The subject matter of the appealed playback claims forms a general inventive concept

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Application No. 08/344,951

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different from that of the inventions defined by the claims of the '131 patent for the following reason: Each of the appealed playback claims recites a device or step for audio normalizing a received video/audio signal. The general inventive concept defined by the appealed playback claims allows the signal output from the devices and methods claimed therein to utilize the full dynamic range of an audio circuit. That same general inventive concept is not present in any of the claims of the '131 patent.

A limitation-by-limitation comparison of the independent claims in the patent to the independent claims in the application is provided infra. To aid in this comparison, the following alphabetical designation has been provided for each signal and element that is claimed in both the patent claims and the application claims:

CLAIMED SIGNAL OR ELEMENT

1. Video signal 35
2. Audio signal 21
3. Memory 31
4. Adaptive Delta Demodulator 23
5. Low-Pass Filter 51
6. Video Normalizer 55
7. Summer 59
8. Video/Data Output Signal 61
9. Disc Mastering Machine/Disc
Reproduction Apparatus
10. Video/Data Input Signal 65
11. Data Normalizer 67
12. Memory 77
13. Adaptive Delta Demodulator 99
14. Analog Audio Output Signal 101

ALPHABETICAL DESIGNATION

A
B
C
D
E
F
G
H
I

J
K
L
M
N

Appeal No. 1999-0189
Application No. 08/344,691

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- 15. Video Output From Disc
Reproduction Apparatus
- 16. Chroma Burst Timing Signal 72
- 17. Vertical Blanking Signal 85
- 18. Horizontal Blanking Signal 87
- 19. Playback Apparatus (Audio/Video)
- 20. Data Flag Signal 73
- 21. Sequence Controller 69
- 22. 7.2 MHZ Enable Signal 75
- 23. Clock Generator 71
- 24. AND gate 83
- 25. Squelch signal 103
- 26. Record Disc

O
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In the following limitation-by-limitation comparison of independent claims 1, 6, 7 and 12 in the patent to independent claims 42, 45, 53 through 59 and 61 in the application, the above-noted alphabetical designations are used for each of the claimed signals or elements. A bold-typed alphabet in the application claims indicates that the signal or element is not in the patent claims:

U.S. PATENT NO. 4,583,131

- Claim 1 - IJLMNOSZ
- Claim 6 - IJLMNOPQRSZ
- Claim 7 - IJLMNOSZ
- Claim 12- IJLMNOPQRSZ

APPLICATION CLAIMS

- Claim 42 - **ABCFG**
- Claim 45 - IJKLMZ
- Claim 53 - **ABCFG**
- Claim 54 - IJKLZ
- Claim 55 - **ABCFG**
- Claim 56 - IJKLMZ
- Claim 57 - **ABCFG**
- Claim 58 - IJKLZ
- Claim 59 - **ABCDEFG**
- Claim 61 - **ABCEFG**

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From the comparison, it is clearly seen that none of the limitations of application claims 42, 53, 55, 57, 59 and 61 (directed to method and apparatus for producing a signal used for forming a record disc) is found in patent claims 1, 6, 7 and 12 (directed to method and apparatus for playing a record disc). Inasmuch as our analysis of these claims agrees with appellant's arguments, we find that appellant has established that the invention claimed in his patent is "independent and distinct" from the invention of the appealed claims 42, 53, 55, 57, 59, 61 and the claims that depend therefrom. In other words, the patent claims and the application claims are patentably distinct inventions.

Each of the independent application claims 45, 54, 56 and 58 includes an audio normalizer for "adjusting a level of said video/data signal to produce a normalized signal which utilizes a full dynamic range of audio circuitry." The examiner has not explained how the application claims with this feature could have been presented at the time of prosecution of the patent claims, or how this claimed subject matter is "covered" by the patent claims no matter what other feature is incorporated in them. It would have been equally helpful for an explanation by the examiner as to why no other evidence of obviousness was needed

Appeal No. 1999-0189
Application No. 08/344,691

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beyond the claims of the patent. In the absence of such a showing or a convincing line of reasoning by the examiner, we agree with the appellant that the added feature in these application claims "is not present in any of the claims of the '131 patent. . . ." and that these claims are "independent and distinct" (i.e., patentably distinct) inventions (Brief, pages 16 and 17).

As a result of the patentable distinctness between the application claims and the patent claims, the examiner could have made a restriction requirement in the originally filed application.

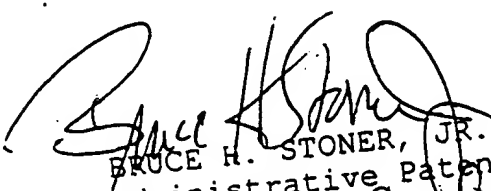
Appeal No. 1999-0189
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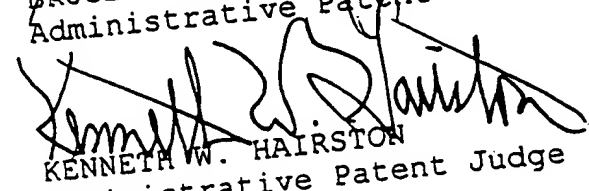
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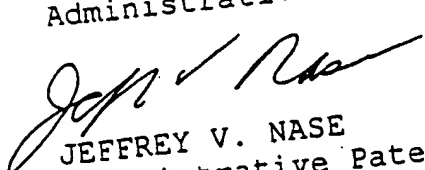
DECISION

In summary, the judicially created doctrine of double patenting rejection of claims 42 through 51, 53 through 59 and 61 is reversed.

REVERSED


BRUCE H. STONER, JR., Chief
Administrative Patent Judge


KENNETH W. HAIRSTON
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

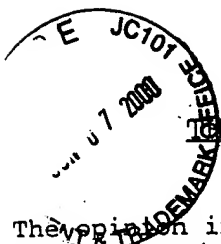
BOARD OF PATENT
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KWH:svt

Appeal No. 1999-0189
Application No. 08/344,691

STEPTOE & JOHNSON, LLP
1330 Connecticut Avenue, N.W.
Washington, D.C. 20036-1795

ATTENTION: Stuart T. F. Huang



THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK H. BAILEY

Appeal No. 1996-1838
Application No. 08/119,655

ON BRIEF

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

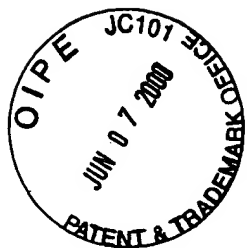
Before STONER, Chief Administrative Patent Judge, HAIRSTON and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65, which are all of the claims pending in this application.

We REVERSE.



BACKGROUND

The appellant's invention relates generally to systems for storing digital information, and, more particularly, to video disc systems for storing digital information in a pulse-length modulation format (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The sole rejection on appeal as set forth in the examiner's answer (Paper No. 32, mailed December 14, 1999) is¹:

Claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 stand rejected under the judicially created doctrine of nonstatutory (i.e., obviousness-type) double patenting over claim 24 of U.S. Patent No. 5,321,680 since the instant application claims are not patentably distinct inventions from the patent claims.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer for the examiner's

¹ Since the other grounds of rejection set forth in the final rejection (Paper No. 16, mailed October 20, 1994) were not set forth in the examiner's answer we assume that these other grounds of rejection have been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

complete reasoning in support of the rejections, and to the brief (Paper No. 19, filed September 18, 1995) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions set forth by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the decision of the examiner to reject claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 under the judicially created doctrine of double patenting must be reversed. Our reasoning for this determination follows.

Double patenting is a legal doctrine that forbids an inventor from obtaining a second valid patent for either the same invention or an obvious modification of the same invention claimed in that inventor's first patent. See In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). The basic concept of double patenting is that the same invention cannot be patented more than once since to do so would result in a second patent that would expire some time after the first patent expired and extend the protection timewise. General Foods Corp. v.

Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279-80, 23 USPQ2d 1839, 1845 (Fed. Cir. 1992); In re Kaplan, 789 F.2d 1574, 1579-80, 229 USPQ 678, 683 (Fed. Cir. 1986).

35 U.S.C. § 101 states "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor..." (Emphasis added). The prohibition of double patenting of the same invention is based on 35 U.S.C. § 101. In re Goodman, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993); Longi, 759 F.2d at 892, 225 USPQ at 648. By "same invention," the court means "identical subject matter." Longi, 759 F.2d at 892, 225 USPQ at 648; In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 621 (CCPA 1970). A good test, and probably the only objective test, for "same invention," is whether one of the claims would be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. Vogel, 422 F.2d at 441, 164 USPQ at 621-22 (halogen is not the "same" as chlorine; meat is not the "same" as pork). All types of double patenting which are not "same invention" double patenting have come to be referred to as "obviousness-type" double patenting. See In re Van Ornum, 686 F.2d 937, 942-43, 214 USPQ 761, 766 (CCPA 1982), which states in

discussing cases leading to Vogel's restatement of the law of double patenting,^{2,3}

numerous cases were considered in which application claims were directed to mere obvious modifications of, or improvements on, inventions defined in the claims of patents already issued to the same inventors, or to common assignees, and it had been decided that they might be allowed to go to patent if the applicants filed terminal disclaimers. We classified these as "obviousness type double patenting." This latter classification has, in the course of time, come, somewhat loosely, to indicate any "double patenting" situation other than one of the "same invention" type.

See also General Foods, 972 F.2d at 1279-80, 23 USPQ2d at 1844-45.

"Obviousness-type" double patenting extends the fundamental legal doctrine to preclude "obvious variants" of what has already been patented. See In re Berg, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998); Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015 and General Foods, 972 F.2d at 1280, 23 USPQ2d at 1845. "Obviousness-type" double patenting precludes issuance where there is no "patentable difference" or no "patentable distinction" between the two claims. Goodman, 11 F.3d at 1052,

² Vogel, 422 F.2d at 441-42, 164 USPQ at 621-22.

³ Judge Rich in Kaplan, 789 F.2d at 1579, 229 USPQ at 682, stated that the restatement of the law of double patenting set forth in Vogel "serves as a good starting place" for deciding the double patenting issue raised in that appeal.

29 USPQ2d at 2015; General Foods, 972 F.2d at 1278-79, 23 USPQ2d at 1844. This allows the public to practice obvious variations of the first patented invention after the first patent expires. See Longi, 759 F.2d at 892-93, 225 USPQ at 648. The courts adopted the doctrine out of necessity where claims in two applications by the same inventor were so much alike that to allow the latter would effectively extend the life of the first patent. See Gerber Garment Technology, Inc. v. Lectra Sys., 916 F.2d 683, 686 16 USPQ2d 1436, 1439 (Fed. Cir. 1990); In re Thorington, 418 F.2d 528, 534, 163 USPQ 644, 648 (CCPA 1969), cert. denied, 397 U.S. 1038, 165 USPQ 290 (1970).

In summary, "obviousness-type" double patenting is a judge-made doctrine that prevents an unjustified extension of the patent right beyond the statutory time limit. It requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide an unjustified extension of the term of the right to exclude granted by a patent. In order to overcome an "obviousness-type" double patenting rejection, an applicant may file a "terminal disclaimer," foregoing that portion of the term

of the second patent that extends beyond the term of the first.
Berg, 140 F.3d at 1431-32, 46 USPQ2d at 1229.

Thus, if a claim sought in the application is not identical to yet **not patentably distinct** from a claim in an inventor's earlier patent, then the claim must be rejected under "obviousness-type" double patenting rejection. See Berg, 140 F.3d at 1431, 46 USPQ2d at 1229; In re Braat, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1991); Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015; Vogel, 422 F.2d at 441, 164 USPQ at 622. In determining whether a claim sought in the application is **patentably distinct** from the claims in an inventor's earlier patent a variety of tests have been utilized. In Berg, 140 F.3d at 1433-34, 46 USPQ2d at 1230-31 and In re Emert, 124 F.3d 1458, 1461-62, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997), a "one-way" test was applied. Under this "one-way" test, the examiner asks whether the application claims are obvious over the patent claims. In Goodman, 11 F.3d at 1052-53, 29 USPQ2d at 2015-16 and Van Ornum, 686 F.2d at 942-43, 214 USPQ at 766-67, a test similar to the "one-way" test was applied. Under this test, the examiner asks whether the application claims are generic to any species set forth in the patent claims. In In re Dembiczak, 175 F.3d 994, 1002, 50 USPQ2d 1614, 1619-20 (Fed. Cir. 1999) and Braat,

937 F.2d at 593-94, 19 USPQ2d at 1292-93, a "two-way" test was applied. Under this "two-way" test, the examiner asks whether the application claims are obvious over the patent claims and also asks whether the patent claims are obvious over the application claims.

We recognize that the examiner's rejection is based in large measure on the decision of the court in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).⁴ However, it is our view that Schneller does not set forth another test for determining "obviousness-type" double patenting. In that regard, it is clear to us that the court in Schneller was concerned with whether or not the invention claimed in the patent was **independent and**

⁴ Schneller is a rather unusual case in that there was no majority opinion because only Judges Rich and Smith joined the principal opinion, while Judges Worley and Kirkpatrick concurred in the result and Judge Almond wrote a concurring opinion. Thus, the principal opinion therein is of doubtful controlling precedent. As Judge Rich observed in Kaplan, 789 F.2d at 1578, 229 USPQ at 682,

[t]he development of the modern understanding of "double patenting" began in the Court of Customs and Patent Appeals (CCPA) about the time of In re Zickendraht, 319 F.2d 225, 138 USPQ 22 (CCPA 1963), a rather unusual case is [sic, in] that there was no majority opinion because only two judges joined each of the two principal opinions. Neither opinion therein, therefore, can be regarded as controlling precedent in this court.

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distinct from the invention of the appealed claims.⁵ While the court in Schneller did use a "cover" test⁶ in making the determination that the invention claimed in the patent was not **independent and distinct** from the invention of the appealed claims, we are of the view that the term "cover" was used by the court as synonymous with not patentably distinct. Thus, under the "cover" test, one would ask whether the application claims are **covered** by (i.e., not patentably distinct from) the claims of the patent. To the extent that Judge Rich in Schneller was setting forth a domination theory⁷ of double patenting, we note that Judge Rich in Kaplan, 789 F.2d at 1577-78, 229 USPQ at 681-82, set forth the Courts opinion that "[d]omination is an irrelevant fact." In any event, it is our view that Schneller did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. In fact, the Court in Schneller, 397 F.2d at 355, 158

⁵ See Schneller, 397 F.2d at 354, 158 USPQ at 214-15.

⁶ As set forth in the Manual of Patent Examining Procedure (MPEP) § 804, one part of the test is whether patent protection for the invention, fully disclosed in and **covered** by the claims of the reference, would be extended by the allowance of the claims in the later filed application.

⁷ A first patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in the second patent or application.

USPQ at 215, cautioned against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.

Accordingly, the question before us in this appeal is whether the application claims are **patentably distinct** from claim 24 of U.S. Patent No. 5,321,680.

With respect to the rejection before us, the examiner has stated the following:

All of the claims of the instant application and patent No. 5,321,680 are drawn to a single embodiment of the invention; the inventions set forth in the claims of the instant application and patent No. 5,321,680 are not independent and distinct from each other. . . . These claims [of the instant application] drawn to a single disclosed embodiment of the invention are considered to be mere obvious variant ways of claiming the same invention within the scope of the meaning of the judicially created doctrine of "obviousness-type" double patenting. [Answer, pp. 10-11].

Instant application claims 59 and 61 and patent claim 24 are not patentably distinct over one another. . . . The subject matter encompassed by instant application claims 59 and 61 and patent claim 24 are obvious variants of one another. [Answer, p. 14].


Our review of the claims under appeal and claim 24 of U.S. Patent No. 5,321,680 leads us to conclude that, absent the presence of additional evidence not before us in this appeal, the

claims under appeal are **patentably distinct** from claim 24 of U.S. Patent No. 5,321,680. In that regard, from a review of the claims under appeal it is quite clear that only claims in the present application recite a record medium/optical disc/disc having a header portion including address information as set forth in claims 8, 32, 54 and 59 (the independent claims on appeal). Thus, claims 8, 32, 54 and 59 and claims dependent thereon are **patentably distinct** from claim 24 of U.S. Patent No. 5,321,680 in the absence of any evidence establishing that the claimed header portion including address information was known in the art. While the examiner has stated that the claims under appeal are obvious variants of claim 24 of U.S. Patent No. 5,321,680, the examiner has not produced any evidence that the claimed header portion including address information was so much as known in the art, much less that it would have been obvious to add such a header portion including address information to the inventor's previously claimed subject matter.⁸


⁸ While the examiner did not require restriction between the claims under appeal and claim 24 of U.S. Patent No. 5,321,680, as far as we are able to determine there would be no reason why it would not have been proper for the examiner to have made a restriction requirement under the criteria of distinctness set forth in MPEP § 806.05(c).

In summary, the examiner has failed to establish that the claims under appeal are not patentably distinct from claim 24 of U.S. Patent No. 5,321,680. Likewise, the examiner has failed to establish that the claims under appeal are obvious from or generic to claim 24 of U.S. Patent No. 5,321,680. Furthermore, it is our view that the facts of this case are sufficiently different from the facts present in Schneller that a double patenting rejection in this application is inappropriate. Accordingly, the decision of the examiner to reject claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 under the judicially created doctrine of nonstatutory (i.e., obviousness-type) double patenting over claim 24 of U.S. Patent No. 5,321,680 is reversed.

To summarize, the decision of the examiner to reject claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 is reversed.


BRUCE H. STONER, JR.
Chief Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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